

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

PAT-01174/BC1-0081

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10/598180

Filed

2006-08-21

First Named Inventor

Bernd Biallas et al.

Art Unit

1792

Examiner

Ryan Raymond Schiro

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/MaryEGolota/

Signature

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

Mary E. Golota

Typed or printed name

☒ attorney or agent of record.  
Registration number 36814

248-524-2300

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

November 6, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below.

☒ \*Total of 2 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:  
Bernd Biallas et al.

Serial No.: 10/598,180

Filed: August 21, 2006

For: METHOD FOR PRODUCING A  
MULTILAYERED FILM F AND USE  
THEREOF

Group Art Unit: 1792

Examiner: Ryan Raymond Schiro

Confirmation No.: 1966

I hereby certify that the attached correspondence is being submitted by EFS-Web as an eFiled Response, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on Friday, November 06, 2009.

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

In conjunction with the Pre-Appeal Brief Request for Review (PTO/SB/33) Applicant requests review for the reasons set forth below.

The Office Action mailed August 6, 2009 finally rejects claims 1-8 and 10-26 under 35 U.S.C. § 103(a) as unpatentable over Hintze-Bruning et al. in view of Fujii et al. This rejection is respectfully traversed.

Applicants' claimed invention is directed to a process for producing a multilayer sheet comprising applying a pigmented basecoat material to a carrier sheet, reducing the residual volatiles content of the basecoat film to less than 10% by weight, adjusting the surface of the basecoat film to a temperature of less than 50°C, if desired applying a second basecoat followed by first reducing the residual volatiles content of the second basecoat film to less than 10% by weight and then adjusting the surface of the second basecoat film to a temperature of less than 50°C, applying a clearcoat, adjusting the residual volatiles content of the clearcoat film to less than 5% by weight, and then curing the coating. The Examiner asserts that Hintze-Bruning et al. disclose each of the elements of Applicants' claimed invention except for adjusting the residual volatiles content of the basecoat film and adjusting the temperature of the basecoat film before

applying the clearcoat, and adjusting the residual volatiles content of the clearcoat film before curing. For these limitations, the Examiner relies on Fujii et al., and since these limitations lie at the heart of Applicants' invention, the teaching of Fujii et al. (or lack thereof) regarding these limitations is critical to determining the patentability of Applicants' claimed invention.

It is well-settled law that a case for *prima facie* case of obviousness must establish that he prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974). In the present case, of the three important limitations (adjusting volatiles content of basecoat, adjusting temperature of basecoat, and adjusting volatiles content of clearcoat), the Fujii et al. reference amazingly *fails to disclose a single one* of these limitations for which the reference is cited.

Taking these limitations one by one, attention is directed to the claim requirement of first adjusting the volatiles content of the basecoat to less than 10% by weight. At col. 7, lines 18-19, the Fujii et al. reference drying the basecoat with hot air to reduce the water content at least to 25% by weight. In Example 4 at col. 11, line 2, the reference discloses drying a basecoat with hot air to reduce the water content to 20% by weight. Nowhere does the reference disclose reducing volatiles content of a basecoat to 10% by weight as required by Applicants' claimed invention. The Examiner however, citing *In re Boesch*, asserts that because residual volatiles content is dependent on drying temperature and that the reference discloses a range of drying temperatures, it would be obvious for one skilled in the art to modify drying temperature in such a way as to arrive at Applicants' claimed 10% residual volatiles content. Applicants respectfully disagree.

First, *In re Boesch* is completely distinguishable from the present case. In *Boesch*, the court's holding that discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art was based on a finding that the "prior art would have suggested the kind of experimentation necessary to achieve the composition", which is not found in the prior art cited by the Examiner in the instant case. Moreover, the 'result' in the 'result effective variable' in *Boesch* was the advantageous result purportedly produced by the invention (i.e., avoidance of

precipitation of embrittling phases of metal alloys), whereas the result urged by the Examiner in this case is the claim element itself of the 10% solids content to which the basecoat is reduced, *not* the advantageous result of the invention of maintaining color flop and physical integrity when the coated film is stretched onto a 3-dimensional part. In *Boesch*, the court found that it was already known in the art that higher values for the 'N v value' parameter (which was to be selected according to a novel equation according to Boesch's claims) would reduce the chance for precipitation of embrittling metal alloy phases (Boesch's purported result). In the present case, no teaching has been shown that would support any expectation that reducing volatiles content of a basecoat before coating a clearcoat onto a carrier film could provide better color and physical stability when that film is applied to complex 3-dimensional shapes, as discovered by Applicants. Instead, the Examiner appears to rely on some sort of inherency or inevitability argument that varying (i.e., increasing) the drying temperature within Fujii et al.'s disclosed range while apparently holding the drying time constant or increasing it (note that the Examiner does not explain this implicit assumption, but it must be made to support the Examiner's conclusion) would inevitably result in the lower volatiles content required by Applicants' claims. However, the Examiner never explains why one would be motivated reduce the basecoat volatiles *to 10%*, as claimed by Applicants.

Fujii et al. also fails to disclose the second important feature of Applicants' claimed invention, adjusting the temperature of the volatiles-reduced basecoat to less than 50°C. There is no teaching in the specification where Fujii et al. actually come out and say to cool the basecoat before coating the clearcoat, but there is a single disclosure in a working example (Example 4 at col. 11, line 1) where the reference discloses cooling a coated element to room temperature before applying a clearcoat. However, a closer look at the disclosure of this working example reveals that element was coated with *two* layers of basecoat prior to drying and cooling followed by the clearcoat. Applicants' claims provide for a second basecoat layer to be applied if desired, but when it is, the first basecoat must be adjusted for both volatiles and temperature *before* the second basecoat is applied. Fujii et al. does not perform either of these steps for the first basecoat, merely allowing it to "set for 2 minutes before the second application of the composition" (col. 10, lines 60-62). Thus, the only disclosure cited by the Examiner of temperature

adjusting a basecoat before applying a clearcoat fails to disclose a basic feature of Applicants' claimed invention.

The third feature referenced above regarding Applicants' claimed invention is to adjust the volatiles content of the clearcoat to less than 5% by weight before curing. Similar to the arguments regarding adjusting the volatile content of the basecoat, the Examiner simply asserts, with minimal supporting analysis, that Fujii's disclosure somehow makes it obvious to adjust the clearcoat volatiles content to 5% as claimed by Applicants. However, a closer examination of Fujii et al.'s disclosure reveals that there is simply no disclosure of reducing volatiles content of the clearcoat to Applicants' claimed 5% level. Fuji et al. disclose at col. 7, lines 23-27 that after application of the clearcoat, "the coated plastics substrate is set in a usual manner and then heated at a temperature lower than about 120°C, preferably about 40°C to about 120°C, to cure the clear coating or the two coatings at the same time. In Example 4 at col. 11, lines 5-7 that the "coating was allowed to set for 5 minutes, dried and cured at 80° to 90°C for 30 minutes." It is unclear whether the reference intends that drying and curing are to occur simultaneously during the heating at 80° to 90°C for 30 minutes or whether by "drying", the reference means reducing the volatiles to 20% volatiles as was done for the double-layer basecoat, but on thing that is clear is that the reference does not disclose or suggest adjusting the volatiles content of the clearcoat to less than 5% by weight before curing it.

As acknowledged by the Examiner, the primary Hintze-Bruning et al. reference does not disclose any of the three above-referenced features of Applicants' claimed invention involving volatiles or temperature adjustment. Furthermore, as discussed above, the secondary Fujii et al. reference also fails to disclose these features, and the Examiner has not provided any persuasive reasoning as to why one skilled in the art would modify the disclosure of Fujii et al. to arrive at the claim elements found in Applicants' invention. Of course, volatiles content of a coating is affected by drying temperature, but that alone does not answer the question of why one would vary the drying temperature in a way to arrive at Applicants' claimed invention when, unlike the case in *Boesch*, there is no art-recognized expectation that such adjustments to volatiles content would produce the beneficial results on coated films when applied to 3-dimensional objects as discovered by Applicants. Additionally, the only teaching by the

secondary Fujii et al. reference regarding cooling of a coated basecoat is clearly outside the scope of Applicants' claims because there is no teaching of cooling (or drying) the first layer of basecoat before applying a second layer of basecoat.

Applicants further point out that their claimed invention is not to perform just one of the three above-described steps, but to do *all* of them, *in order*, and not just on any substrate, but on a carrier sheet substrate where the advantages discovered by Applicants of retained color flop and physical integrity when applied to a 3-dimensional shape are uniquely felt. Applicants submit, therefore, that simply supplementing the Examiner's rejection with additional references that may individually show drying of a basecoat to less than 10% volatiles, or cooling a basecoat to less than 50°C, or drying a clearcoat to less than 5% volatiles will not strengthen the rejection. To the contrary, Applicants submit that a necessity for so many references would merely serve to further illustrate the unobviousness of Applicants' claimed invention of the combination of performing each of these steps, in order, on a carrier sheet substrate.

## CONCLUSION

As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

/MaryEGolota/

Mary E. Golota  
Registration No. 36,814  
Cantor Colburn LLP  
(248) 524-2300

Friday, November 06, 2009  
CORRESPONDENCE ADDRESS ONLY

BASF CORPORATION  
1609 Biddle Avenue  
Wyandotte, MI 48192  
Customer No. 77224

MEG/PM